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In the Supreme Court of the United States

October Term, 1983

MTD PRODUCTS INC,
Petitioner,
vs.
RADIO STEEL & MFG. CO.,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Federal Circuit

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QUESTIONS PRESENTED

1. Is the law enunciated in 1938 by this United States Supreme Court in the case of *Lincoln Engineering v. Stewart-Warner,* 303 U.S. 545, 37 U.S.P.Q. 1, still law binding on the United States Court of Appeals for the Federal Circuit notwithstanding the enactment in 1952 of the present patent statutes, and particularly the requirement for obtaining a patent as stated in present 35 U.S.C. 112, that:

> "The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention."?

2. Has the law as enunciated in 1938 by this United States Supreme Court in said *Lincoln Engineering* case, and since followed to date as an authority by many Circuit Courts of Appeal and District Courts, been repealed by the enactment of the present patent statutes in 1952?

3. Is the patent in suit, Tonelli No. 3,282,600 (App. A53), in attempting to claim as the patent property of Respondent (Radio) an *entire* wheelbarrow (bowl or tray, handles, front bumper plate, wheel, legs and bracing structure), but including (as part of the entire wheelbarrow claimed) a purported improvement in a part of the bracing structure, valid in view of the law established in the 1938 decision of the Supreme Court in *Lincoln Engineering*?

RULE 28.1 STATEMENT

There is no parent corporation of Petitioner, an Ohio corporation, and there are no subsidiaries other than wholly owned subsidiaries. Affiliates of Petitioner are Valley City Steel Co., an Ohio corporation; Luk, Inc., an Ohio corporation; Morse Rubber Products Co., an Iowa corporation; Agrifab, Inc., an Illinois corporation; and E. P. Barrius, Ltd., a United Kingdom corporation.

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To The Honorable, The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, MTD Products Inc, respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit entered March 29, 1984 and of the denial of a Petition for Rehearing entered May 2, 1984.

CITATIONS TO OPINIONS BELOW

The opinion and judgment of the Court of Appeals for the Federal Circuit entered March 29, 1984 and of which review is requested, reported at ..... F.2d ....., 221 U.S.P.Q. 657, is printed in the Appendix (App. A1) to this Petition, and the Order denying Rehearing is printed in the Appendix (App. A51) to this Petition.

The decision of the United States District Court for the Northern District of Ohio, Eastern Division is printed in the Appendix (App. A18, A50) to this Petition, and reported at ..... F.Supp. ....., 220 U.S.P.Q. 35.

JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered March 29, 1984 and Rehearing was denied May 2, 1984.

Jurisdiction of this Court is invoked under the provisions of 28 U.S.C. 1254(1).

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

Constitution of the United States, Article VI, Clause 2:

> "This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding."

The Federal Statutes involved and to be considered are:

Present 35 U.S.C. 112, enacted in 1952, stating as a requirement for obtaining a patent that:

> "The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which applicant regards as his invention."

Former patent statute 35 U.S.C. 33 in force at the time of the 1938 *Lincoln Engineering* decision, similarly requiring that:

> "* * * He (applicant) shall particularly *point out and distinctly claim* the part, improvement, or combination which he claims as his invention or discovery. * * *"

STATEMENT UNDER SUPREME COURT RULE 28(.4)(b)

In this case the constitutionality of an Act of Congress has not been drawn in question.

STATEMENT OF THE CASE

The Petitioner (sometimes referred to as MTD) is an Ohio corporation having its principal place of business at Cleveland, Ohio.

The Respondent (sometimes referred to as RADIO) is an Illinois corporation having its principal place of business at Chicago, Illinois.

The action is one for infringement of U.S. Patent No. 3,282,600 issued November 1, 1966 to Tonelli on a Wheelbarrow (App. A53). The patent, now expired, was assigned to RADIO who charged MTD with infringement for making and selling wheelbarrows.

MTD denied infringement because the wheelbarrows it made did not incorporate the purportedly improved part of the bracing structure of the wheelbarrow which was specifically claimed in the Tonelli patent in suit.

MTD, relying upon the established principle of United States Patent Law that patent property is limited to the invention itself, attacked the validity of the patent because erroneously issued by the Patent Office directly contrary to the law clearly enunciated in 1938 by this Supreme Court in the *Lincoln Engineering* case.

Wheelbarrows are indeed ancient vehicles and their structure and uses have been known for many, many years. Some examples of various old wheelbarrows are shown in the cited prior patents of record in this case (App. A59-A99). These old wheelbarrows include a bowl or tray for holding a load, long handles, legs, a wheel, some kind of a bracing structure between the parts, and a front bumper plate if desired (such as shown for example in Smith I patent, App. A63; Smith II patent, App. A66, and Millar patent, App. A99), and may also include split or two-piece wooden handles to facilitate the packing in a carton of a dis-assembled wheelbarrow with the wooden handle portions separated (such as shown for example in Smith II patent, App. A.66, and Booth patent, App. A.86).

The wheelbarrow of the Tonelli patent in suit and the old wheelbarrows of which the cited prior patents are examples, all operate in exactly the same way, produce precisely the same result, and their weight and strength are all dependent on the choice of materials and dimension of the parts. The Tonelli patent (App. A53) and prior Smith II patent (App. A66) and prior Booth patent (App. A86) also incorporate split or two-piece wooden handles for facilitating packaging of the dis-assembled wheelbarrow for shipping. The idea of the split or two-piece wooden handles has not been advanced by anyone as novel.

For the purpose of demonstrating the parallelism of the salient facts of this case to the salient facts in the *Lincoln Engineering* case, the patent monopoly attempted

by Tonelli to be secured on wheelbarrows is here examined.

Independent claim 2 of the patent in suit (App. A57) is the claim upon which RADIO depends, and upon which is premised the Court of Appeals' decision of March 29, 1984. The parts included in the listed parts of that claim are here set forth with the numbers in parentheses referring to reference characters in the patent drawings.

1. A bowl (10);

2. A pair of elongated handles (40) having forward piece (40a) and rearward piece (40b) as shown in the drawing, FIG. 3;

3. A bumper plate (46) at the forward ends of the handles;

4. A cross brace member (72) extending crosswise between the handles (40) and beneath the bowl (10) with *channel sections (80)* on the outer end portions of the cross brace member (72) spaced one from the other by an amount corresponding to the spaced relationship between the handles and having a *width dimensioned to correspond to the width of the handle portions* (40a, 40b) *to receive the handle portions therein in fitting relationship* and means for securing the handle portions (40a, 40b) *in* the channel sections with the two pieces aligned in end to end relation and with the abutting end *in* an intermediate portion of the channel section;

5. A pair of leg members (60) and inverted U-shaped bracing members (94) connected (at 92) to the cross brace member (72) and the foot (62) of the leg members (60) and

6. A wheel (12) mounted at the front ends of the forward pieces (40a) of the handles (40).

The portions of the claim which have been italicized for emphasis are directed to the channel sections on the outer end portion illustrated in cross-section on the second page of the decision of March 29, 1984 by the Court below (App. A2). The italicized part of the patent claim describes in detail both the structure and the function of the channel sections.

The patent specification makes clear the asserted importance of these channel sections formed on the end portions of the cross brace member in holding in alignment the two abutting ends of the split or two-piece wooden handles, by the statement (column 5, lines 38, 41, App. A57)

> "The handle members are *gripped* by the channel sections 80 of the cross brace member in a manner to militate against *lateral displacement* or relative movements between the sections." (Emphasis added throughout.)

The meaning of "channel shaped", although generally understood by all, was further specifically defined in the patent specification at column 3, lines 63-69 (App. A56) by the definition:

> "* * * with the end portions (of the cross brace member) being formed with a *down turned* portion 78, a flat horizontally disposed portion 80, and an *upwardly turned* end flange 82 to define a lengthwise channel section therebetween dimensioned to have a width corresponding to the width of the abutting portions of the handle pieces 40a and 40b for *receiving* the abutting end portions of the handle pieces *therein*."

It was admitted in the trial that the accused MTD cross brace member did not have *channel shaped* end sections, but had *flat* end sections as shown in the assembly

drawing of MTD's owner manual (App. A102). This *omission* of the feature of channel shaped sections on the ends of the cross brace member was *conceded* by the District Court (App. A39).

Based upon the personal opinion of RADIO's hired expert witness (App. A14) that the *flat* ends of the MTD accused cross brace member were the "equivalent" of the channel shaped end sections claimed by the patent, the District Court (App. A39-A40) concluded that the flat ends were the "equivalent" of the channels. The decision of March 29, 1984 by the Court of Appeals concurred with this conclusion based on an unsupported "opinion".

This conclusion was arrived at notwithstanding a complete absence in the record of any evidence *establishing as a fact* that a *flat* end on a cross brace member of the accused MTD wheelbarrow has the structure, or performs the function, or produces the results provided by the channel shaped sections specifically called for by the patent claim 2. Even without such evidence, it is *self evident* that a *flat* end portion does not have a channel structure with a width dimensioned to correspond with the width of the handle portions to *receive* the handle portions *therein* in fitting *relationship.*

Although totally disagreeing with the decision below holding that the patent in suit is valid and holding the patent to be infringed on the basis of "equivalency", as above discussed, MTD is making the assumption for the purposes of this Petition that *some change* was made by Tonelli, the patentee, in his wheelbarrow. If no change whatever was made, then his wheelbarrow was the same as the ancient wheelbarrows known throughout history. Unless *some* modification is asserted for RADIO's patented wheelbarrow, then the claims would read on and be 100%

anticipated by the prior patents such as for example the wheelbarrows shown in these prior U.S. patents:

No. 187,549	Nutting et al*	(App. A59)
No. 1,622,354	Smith I*	(App. A62)
No. 1,630,975	Smith II*	(App. A66)
No. 155,084	Harrison	(App. A69)
No. 258,323	Shumaker	(App. A71)
No. 355,245	Annin	(App. A73)
No. 562,139	McCabe	(App. A77)
No. 686,298	Hoffmann	(App. A80)
No. 888,055	Baker	(App. A83)
No. 1,242,418	Booth	(App. A86)
No. 1,559,646	Roemer	(App. A89)
No. 1,578,213	Smith III	(App. A94)
No. 3,170,707	Millar	(App. A98)

The *only* perceivable modification that Tonelli incorporated in his patented wheelbarrow is the *channel shaped sections* at the ends of his cross brace member for receiving in fitting relationship the abutting ends of split or two-piece handle portions so as to grip the handles and to hold them in alignment and against angling relative to each other. There has been *no suggestion* by RADIO, by the District Court, nor by the Court of Appeals' decision of March 29, 1984, that there is any other modification found in the Tonelli patent in suit. This distinction, emphasized so strongly in the patent claim 2 is the *only* perceptible difference that can be found over the many very old wheelbarrows.

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*Cited by the Patent Office in the prosecution of the Tonelli patent in suit.

REASONS FOR GRANTING RELIEF

1. The Law of the Lincoln Engineering Case Is Binding Upon the Court of Appeals for the Federal Circuit Under the Provisions of Article VI, Clause 2 of the Federal Constitution, and Failure to Follow That Law Is Not Excused by Enactment of the 1952 Patent Act.

For the purpose of discussing the application of the *Lincoln Engineering* decision to this case, it may be *assumed* that Tonelli, in making the patented wheelbarrow, invented the improvement of the *channel shaped sections* which receive in fitting relationship the abutting ends of the wooden handle portions to hold them in alignment. *If* this assumption is not made, then the patent in suit is fully anticipated by the above cited prior patents and the claim would be invalid for that reason.

The present case is a classic example of the kind of situation to which the *Lincoln Engineering* decision directly applies. Claim 2 of the patent catalogues six different elements which put together would comprise any old wheelbarrow. There is no need to refer to the above prior patents of record because any gardener, or person having occasion to move material about, and almost everybody knows that all wheelbarrows include a wheel, a bowl or tray, handles, legs, a bracing structure of some kind, and sometimes also a bumper or guard at the front of the handles.

If Tonelli made an invention, it could only have been in the assumed modification of the channel shaped end of a cross brace member as so carefully and painstakingly set forth in his claim. Only *one element* of the congrega-

tion of elements listed in Tonelli's patent claim could possibly be said to have been improved by Tonelli.

The salient facts in this case are remarkably parallel to the facts in the governing case of *Lincoln Engineering v. Stewart-Warner*, 303 U.S. 545, 37 U.S.P.Q. 1.

In the *Lincoln Engineering* decision, it appeared that *the aggregation* (an apparatus for supplying grease to the fittings or nipples of bearings of an automobile) comprising (1) a compressor or pump for pumping grease under pressure, (2) a hose or conduit for supplying the pumped grease to the fitting or nipple of the bearings, and (3) a coupler for coupling or attaching the hose or conduit to the fitting or nipple of the bearings, was *old* and had been previously patented.

The patentee (Stewart-Warner Corporation) had made an invention of an improved coupler. However, instead of confining its patent claims to the improved coupler, Stewart-Warner overextended itself and tried to monopolize the combination of pump, hose, and *improved* coupler. The general combination of A, B and C was old, and Stewart-Warner tried to monopolize, by means of its invalid claims, the combination of A, B and C′ in which C′ (prime) represented the improved coupler.

By this tactic, Stewart-Warner attempted to put itself in the position of being enabled to exact tribute or obtain royalties on the *whole* apparatus of pump, hose and coupler. It did not confine its asserted monopoly to the invented improved coupler.

The law enunciated in the *Lincoln Engineering* decision had been followed in the following cases that have cited that decision as controlling authority:

Thomas & Betts v. Steel City Electric, 122 F.2d 304, 50 U.S.P.Q. 230 (3rd Cir. 1941)

Heyl & Patterson v. McDowell Co., 317 F.2d 719, 137 U.S.P.Q. 620 (4th Cir. 1963)

Stukenborg, et al. v. Teledyne, Inc., 299 F. Supp. 1152, 161 U.S.P.Q. 10 (D.Ct. Cal. 1969), *affirmed*, 441 F.2d 1069, 160 U.S.P.Q. 584 (9th Cir. 1971)

Trico Products Corp. v. Roberk Co., 369 F. Supp. 1146, 178 U.S.P.Q. 589 (D. Conn. 1973), *affirmed*, 490 F.2d 1280, 180 U.S.P.Q. 289 (2 Cir. 1973)

Avery Products Corp. v. Morgan Adhesives, 496 F.2d 254, 181 U.S.P.Q. 737 (6th Cir. 1947)

Parker v. Motorola Inc., 524 F.2d 518, 188 U.S.P.Q. 225, 236 (5th Cir. 1975)

Duplan Corp. v. Deering Milliken, 144 F. Supp. 648, 197 U.S.P.Q. 342 (D.Ct. S.C. 1977)

Bon Trager v. Steury, 457 F. Supp. 526, 201 U.S.P.Q. 813 (N.D. Ind. 1978)

The situation in the instant case before the Court parallels the situation found in those cited cases. In those cases, as in *Lincoln Engineering*, the patentee had made an improvement in but one element of an old aggregation but nevertheless claimed the old assembly of parts and substituted for an old element a novel element. Such overreaching has been condemned in those cases as it should be here by holding such erroneously issued claims to be invalid.

In all these cases of *Lincoln Engineering* and those following it, the Patent Examiner had made a mistake by not following controlling law. The Courts in these cases held the Examiners to be wrong and the patent invalid. Although 35 U.S.C. 282 states that "A patent shall be *presumed* valid", that presumption does not prevent patents

from being held by the Courts to be invalid when a mistake in the issuance of a patent has been found.

Patent Examiners need not be lawyers nor do they always follow the dictates of controlling law when passing on patent applications. The number of patents held invalid by the Courts reflect this failure to comply with the law. At times, the Examiners need to be reminded that they must obey the law as laid down by the Supreme Court. For example, the Patent and Trademark Office in 1973 (long after the *Lincoln Engineering* decision) had to remind Patent Examiners:

> "In our opinion, Supreme Court decisions *must be followed* by the Patent Office."
>
> *Ex parte Varga,* 189 U.S.P.Q. 204, 207 (P.O. Bd. App. 1973)

Under Article VI, Clause 2 of the Federal Constitution, the decisions of the Supreme Court made pursuant to the Constitution become the Supreme Law of the Land.

The Supreme Court said in its *Lincoln Engineering* decision:

> "As we said of Gullborg in the Rogers case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is, therefore, *void* as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

Those same words may well be applied to the instant case. In the *Lincoln Engineering* case the only discernible difference found in the patent over the prior lubricating apparatus was a modified coupler. In the instant case, the only discernible difference over the old and well known wheelbarrows is the channel shaped end sections on the cross brace member of the patented wheelbarrow.

It is the established law that a patent claim endeavoring to include as the patentee's patent property all of an old assembly of parts when only one of those parts has been improved and the new assembly functions just as did the old assembly, is invalid.

This law controls even if there is substituted a so-called "equivalent" of the improved part. The law of *Lincoln Engineering* applies *even if* one indulges in the fiction that another part is the "equivalent" of the improved part, such as that a flat piece of metal is the "equivalent" of a channel which receives and grips abutting ends of a wooden handle section.

2. The Age of the 1938 Decision of This Court in Lincoln Engineering Does Not Justify Present Disregard of the Principle Stated in Lincoln Engineering, the Statutory Requirements for Claiming the Invention Being the Same After 1952 As It Was Under the Statutory Requirements in 1938.

The Court of Appeals' decision of March 29, 1984, on page 10 of the opinion, gave as a reason for not following the law laid down by the Supreme Court is the *age* of that Court's 1938 decision. It there stated:

> "*Lincoln Engineering* does *not* control this case for another reason. *Lincoln Engineering* was decided

more than 20 years (sic) before the present patent code was enacted in 1952. The question, therefore, is what significance, if any, that decision has on interpreting and applying the different statutory provisions of the present law." (App. A9)

It is submitted that the law enunciated by this Supreme Court in 1938 is still controlling law today. The enactment in 1952 of the present patent statutes in no way changed the law stated in *Lincoln Engineering.*

Of the decisions listed above on pages 10 and 11 of this Petition and which cited and followed *Lincoln Engineering,* seven of these decisions were *subsequent* to the enactment of the 1952 Act. The Courts in those cases did not appear to believe that the law of *Lincoln Engineering* had been overruled by the Supreme Court; by Congress in enacting the 1952 Patent Statute; nor by nullification of that law by others.

The wording of the 1952 Patent Act, particularly in 35 U.S.C. 112 directed to patent claims, is strikingly similar to the corresponding portion of the former statute on the subject.

Present 35 U.S.C. 112 requires that:

"The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention."

Former patent statute, 35 U.S.C. 33, in force when the Supreme Court in 1938 rendered its *Lincoln Engineering* decision, on the point of claims, similarly required:

"* * * He (applicant) shall particularly *point out and distinctly claim* the part, improvement, or combination which he claims as his invention or discovery. * * *"

Therefore, it can readily be seen that the enactment of the 1952 Patent Act in no manner changed the law of *Lincoln Engineering*. The age of that 1938 decision and the lapse of 14 years until Congress in 1952 enacted new patent statutes is no justification whatever for ignoring the application of that controlling law enunciated by the Supreme Court.

3. The U.S. Court of Patent Appeals, Predecessor of the Court of Appeals for the Federal Circuit, Had No Authority to Attempt to Overrule the Law of Lincoln Engineering Even If It Considered It Unsound, and Reliance of the Court of Appeals for the Federal Circuit Upon Such a Prior Ruling of the Court of Customs and Patent Appeals Is Not a Justification Now for Failure to Apply the Established Law of Lincoln Engineering.

Another basis for the decision of March 29, 1984 by the Court of Appeals was its citation (App. A9) of *In re Bernhart and Fetter*, 417 F.2d 1395, 163 U.S.P.Q. 611 (C.C.P.A. 1969) which was by the Court of Appeals predecessor, the U.S. Court of Customs and Patent Appeals. (As of October 1, 1982, the functions of the Court of Customs and Patent Appeals, the Court of Claims, and the other Courts of Appeals, insofar as they handled appeals in patent cases, were bestowed on the newly created U.S. Court of Appeals for the Federal Circuit. 28 U.S.C. 1295.) The Court of Appeals commented:

> "In *In re Bernhart and Fetter*, the Court of Customs and Patent Appeals * * * after discussing *Lincoln Engineering*, held that under the *present* statute the *only* proper basis for an old combination rejection is 'that portion of section 112 which requires that the claims specifically point out and distinctly claim the invention'." (App. A9)

This is in effect a contention that the law of *Lincoln Engineering* is *not a basis* for rejecting such claims to an old combination having an improved element. It seems to be a contention that the portion of present 35 U.S.C. 112 directed to the requirement for claims is different from the corresponding portion of former 35 U.S.C. 33 in force when the Supreme Court decided *Lincoln Engineering*.

As spelled out above, the portions of the old statute and of the new statute in respect to the requirements for claims are substantially the same.

Examination of the 1969 decision of the Court of Customs and Patent Appeals in *Bernhart and Fetter* discloses that it presents no justification for not applying the law of *Lincoln Engineering* to the instant case.

The *Bernhart and Fetter* decision rejected the authority of *Lincoln Engineering* by holding that the present statute, 35 U.S.C. 112, is the *sole* proper basis for rejecting such a claim on an old aggregation of elements including an improved element. In that *Bernhart and Fetter* case the examiner had rejected apparatus claims under present 35 U.S.C. 112. The Court of Customs and Patent Appeals in its decision, after referring to the *Lincoln Engineering* decision, concluded:

> "Our primary concern, however, is not with the *soundness* of the underlying policy (as stated in Lincoln Engineering-? Ed.), if any, for *old* combination rejections; it is whether such rejections are proper under the *present* statute. * * * We think that the *statutory* language (in present 35 USC 112-Ed.) is the *only* proper basis for an old combination rejection, and in applying the rejection *that* language determines what an applicant has a right and an obligation to do." (417 F.2d 1395, 163 U.S.P.Q. 611)

The basis for the views expressed in *Bernhart and Fetter* regarding the *soundness* of the law enunciated in

Lincoln Engineering, is found in its critical comments upon the law of *Lincoln Engineering* holding that a patentee *could not properly claim* an old combination which included an improved element:

> "Why an applicant should not be so entitled is *not clear*. Many cases have said that the combination claim reciting only one new element with no new result is overclaiming or claiming more than the applicant invented. *Such statements are indeed puzzling* in view of the fact that the addition of elements to a claim narrows its scope and thereby creates a lesser monopoly. Others have said the combination is not new, or is obvious, if no new coaction or result is obtained. This too is *unsound*, since it is not the result which is to be patented but the recited machine, composition, etc." (417 F.2d 1395, 163 U.S.P.Q. 611)

It is respectfully and sincerely submitted that the 1969 decision of *Bernhart and Fetter* by the Court of Customs and Patent Appeals does not and cannot change the law of *Lincoln Engineering* enunciated by the Supreme Court in 1938 and ever since (and since 1952) faithfully followed by numerous Courts of Appeals and Districts Courts.

The fact that the law of *Lincoln Engineering* is still in force and binding upon the courts has been *confirmed* by Mr. James P. Ryther, attorney for RADIO, the respondent in the instant case. In the case of *Schutt Manufacturing Company v. Riddell, Inc.*, appearing there as attorney for the defendant, he attacked the validity of the Plaintiff's patent for overclaiming under the law of *Lincoln Engineering*.

In this *Schutt* case in 1979 (long after the passage of the 1952 Patent Act) pending in the U.S. District Court for the Northern District of Illinois, Mr. Ryther *persuaded*

that Court by a Motion for Summary Judgment that a claim to an entire football helmet cataloging the parts of the same of a helmet, a mask, and resilient straps for securing the mask on the helmet, was invalid under the law of *Lincoln Engineering,* even if it were conceded that the resilient straps themselves were new. Insofar as ascertained, the decision of the District Court holding the patent claim on the entire helmet to be invalid under the law of *Lincoln Engineering* has not been reported.

Upon appeal of the *Schutt* case to the Seventh Circuit Court of Appeals, Mr. Ryther again urged the applicability of *Lincoln Engineering* and argued for affirmance of the holding of invalidity of the claim for overclaiming under the law of *Lincoln Engineering.*

On the appeal, the Court of Appeals, in its 1982 decision reported at 673 F.2d 202, 216 U.S.P.Q. 191, affirmed the holding of invalidity of the claim for obviousness but did not reach the question of invalidity under *Lincoln Engineering.* The Court of Appeals stated:

> "In light of our affirmance of the district court's obvious determination, we need not reach the question of whether that court correctly applied the overclaiming doctrine of *Lincoln Engineering v. Stewart-Warner Corp.* * * *".

It thus appears that RADIO's attorney, Mr. Ryther, does not agree with the view expressed in the decision of March 29, 1984 by the Court of Appeals below that passage in 1952 of the present Patent Act changed the law stated in the 1938 decision in *Lincoln Engineering.* Neither did the judges in the many other decisions of the Circuit Courts of Appeals and District Courts rendered since 1952 believe that the law of *Lincoln Engineering* had been changed.

There is a sound public policy in the principle of *Lincoln Engineering*: A wholesome and fair result requires that patent protection be *restricted to the new invention.* It is only equitable that the inventor of a part or element be barred from asserting as *his* patent property the environment or the old collection or assembly of parts in which the improved part or element may be used.

In the instant case, an accounting for the assessment of damages has been directed. No degree of fairness could possibly be perceived in requiring MTD to pay damages or a "reasonable royalty" in lieu of damages or lost profits on an *entire wheelbarrow,* including tray or bowl, handles, legs, wheels and bracing structure. The soundness of the policy of *Lincoln Engineering* is emphasized and given real meaning when such a grotesque result is contemplated.

If a person makes an improved carburetor for an automobile, shall he be entitled by his over-reaching claim to the *entire* automobile including his improved carburetor? May he exact tribute as royalties under a license, or by assessment of damages in an infringement suit, based upon the *whole automobile?*

It would indeed be difficult for industry to operate if the law of *Lincoln Engineering* is not faithfully followed and obeyed. Patents are for the protection of inventions, not for stifling the manufacture and sale of old well-known background apparatus or the environment in which the invented part may happen to reside.

The sound principle of patent law that patent protection is to be granted solely on the new invention, as so clearly and unmistakably stated in the *Lincoln Engineering* case, is to be maintained and safeguarded for the benefit of *both* inventors and users of inventions.

The Court of Appeals for the Federal Circuit was created in 1982 to handle all appeals in patent cases from the District Courts and thus tend to make more uniform and consistent the decisions in patent cases. The District Courts are, of course, also bound to follow the decisions of this Supreme Court in patent cases. For the Court of Appeals for the Federal Circuit to fail to follow this Court's decision in *Lincoln Engineering*, as it did here, can only create confusion for the District Courts and others.

There is a need for guidance of the Patent Office Examiners, of all the Courts below, of inventors, of users of inventions, and of patent attorneys, as to the present binding effect of this Court's 1938 *Lincoln Engineering* decision.

CONCLUSION

The law of *Lincoln Engineering* is still in force and applicable to this case. Under that law, the patent in suit (No. 3,282,600) is unquestionably invalid, and being invalid, it is not infringed, regardless of any theory of equivalents.

Maintenance of the principle that protection under the patent statutes is only for the new invention is important for the interests of the patentee and of the public.

PRAYER

The Petitioner asks that by a Writ of Certiorari the decision below of the Court of Appeals for the Federal Circuit be reviewed, that the decision be reversed as contrary to law, and that judgment be granted in favor of Petitioner

on the basis of the invalidity and consequent non-infringement of the Tonelli patent in suit.

Respectfully submitted,

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APPENDIX

DECISION OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Decided March 29, 1984)

Appeal No. 83-1231

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RADIO STEEL & MFG. CO.,
Appellant,

v.

MTD PRODUCTS, INC.,
Appellee.

Before FRIEDMAN and MILLER, *Circuit Judges,* and RE, *Chief Judge.**

FRIEDMAN, *Circuit Judge.*

This is an appeal from a judgment of the United States District Court for the Northern District of Ohio in a patent infringement suit. The court held that United States Patent No. 3,282,600 (the '600 patent) covering a wheelbarrow, which the appellant Radio Steel & Mfg. Co. (Radio) owns, is valid but was not infringed by a wheelbarrow manufactured and sold by the appellee, MTD Products, Inc. (MTD). 220 USPQ 35 (1983). We affirm the determination of validity but reverse the determination of noninfringement, and remand the case to the district court for an accounting.

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*EDWARD D. RE, *Chief Judge of the United States Court of International Trade*, sitting by designation.

I

A. A wheelbarrow is an old and well-known device used to transport heavy and bulky materials. A wheelbarrow usually **[2]** includes a bowl which carries the material to be transported, a pair of long handles that support the bowl, a wheel at the front end of the structure between the handles, and two legs which form a tripod with the wheel upon which the bowl rests when it is being loaded and unloaded. Wheelbarrows also usually include various supporting and bracing elements.

Previously, wheelbarrows generally were assembled at the factory. An assembled wheelbarrow, however, is relatively large, which makes it impractical to package for shipment and difficult and expensive to ship and store. The specification of the '600 patent described the invention as "a strong and rugged wheelbarrow such as may be used for construction work and in which the wheelbarrow can be fabricated, packaged, distributed and sold as separate elements in 'knocked down' condition for assembly by the user to provide a new and improved wheelbarrow of rugged construction."

Claim 2 of the '600 patent, the only claim we consider (*see infra* pp. 8-9), describes a wheelbarrow in which each handle is composed of two pieces that, when assembled, abut end to end. At their juncture, these pieces are supported on their underside by a cross brace between the handles and also from above by being bolted onto the bottom of the bowl. The cross brace looks like this in simplified cross section:

and has at each end a square U-shaped channel into which a handle fits. The claim also describes a wheel between the two [3] handles at their front ends, the bowl, two V-shaped legs with their upper ends connected to the handles, and "means" for mounting and attaching the various components.

The patent issued in November 1966. It contains 10 claims, of which only claims 1 and 2 are independent, with the remainder being directly or indirectly dependent on claim 2.

B. MTD manufactured and sold a noninfringing wheelbarrow from 1970-1978, when it left the wheelbarrow business. It returned to the business in 1980. In the summer of that year, it exhibited its new wheelbarrow at a hardware show. That wheelbarrow was virtually identical to the wheelbarrow the '600 patent covered. Radio so informed MTD and requested MTD to stop the infringement. In response, MTD "changed the ends [of the cross-brace] to flat and did away with the channel." It manufactured and sold its wheelbarrow with this altered cross brace.

Radio filed the present infringement suit in July 1981. MTD filed an answer and counterclaim for declaratory judgment seeking a determination that the '600 patent was invalid, not infringed, and not enforceable. Both parties sought attorney's fees.

After a two-day bench trial, the district court held the '600 patent valid but not infringed. With respect to validity, the court noted that MTD relied upon 10 patents the examiner had not cited. The court concluded, however, that "none of them demonstrates any features disclosed by the '600 patent [4] which are not represented in the cited art." The court held that all the claims met

the definiteness requirement of 35 U.S.C. § 112 (1976); that the prior art did not anticipate the claims of the '600 patent because "in no single pre-existing structure or description are there all of the elements of the plaintiff's patented devices or their equivalents"; and that "the differences between the subject matter of the '600 patent and the prior art are such that the subject matter as a whole was not obvious at the time the invention was made to a person having ordinary skill in the art."

With respect to infringement, the court held that there was no literal infringement because "the defendant's cross brace, with its flat ends, is of a somewhat different shape than the cross brace of the plaintiff's patent, which has channel shaped sections on its opposite ends." The court further ruled, however, that "the defendant's cross brace is the equivalent of the cross brace in the '600 patent."

The court pointed out that "[t]he claimed function of the end sections of the cross brace in the plaintiff's patent is to secure the handle portions with the two pieces aligned in abutting relationship to form complete handles. The flat ends of the defendant's cross brace perform this same function in substantially the same way—that is, by bridging the handle pieces and being bolted to each piece." The court concluded that "if determination of infringement of the '600 patent by **[5]** the defendant's wheelbarrows involved only consideration of the equivalency of the cross brace members, this Court would conclude that the patent was indeed infringed."

The court, however, refused to find infringement, on the ground that "there exists a significant difference between the structure claimed in the '600 patent and that of the defendant's wheelbarrows." The "significant difference" was that although MTD's wheelbarrow contained filler strips, which were shims placed between the handles

and the bowl, the claims of the '600 patent do not mention those strips.

The court noted that filler strips "are mentioned frequently in the specification of the '600 patent." It declined, however, to read the "means" language in the claim as incorporating into the claims the filler strips, which it viewed as "integral structural components" of the MTD wheelbarrow that the claims of the '600 patent do not cover. The court stated: "Just as the inclusion into the '600 patent of the multi-purpose cross brace results in a new type of wheelbarrow with a new, improved, and specific interaction among its elements, so the inclusion into the defendant's wheelbarrows of filler strips, although not new elements, creates a different structure."

The court denied MTD's motion for attorney's fees, ruling that it could not find that this is an "exceptional case" under 35 U.S.C. § 285.

C. Radio's appeal challenges the district court's finding of noninfringement. MTD defends that finding and also attempts **[6]** to support the district court's judgment in its favor by arguing that the patent is invalid. It also contends that it is entitled to attorney's fees. We believe it will aid the discussion of the issues first to consider validity, and then infringement.

II

A. There is a threshold issue whether MTD's failure to cross-appeal on the validity issue precludes it from now arguing that point. The general rule is that, without taking a cross-appeal, the prevailing party may present any argument that supports the judgment in its favor. *United States v. American Railway Express Co.*, 265 U.S. 425, 435 (1924); 9 J. Moore, B. Ward, & J. Lucas, *Moore's*

Federal Practice ¶ 204.11[3] (2d ed. 1983). This rule has been applied in some interference proceedings. *See, e.g., Klemperer v. Price,* 271 F.2d 743, 123 USPQ 539 (CCPA 1959). It is unclear, however, how that rule applies in this case.

The pertinent portion of the judgment of the district court is as follows:

> For the reasons stated in the Memorandum Opinion contemporaneously filed, IT IS ORDERED, ADJUDGED, and DECREED that the plaintiff's United States Letters Patent No. 3,282,600 is valid but not infringed by the defendant's products. Judgment is entered in favor of the defendant and against the plaintiff on all aspects of the plaintiff's complaint except validity and in favor of the plaintiff and against the defendant on the defendant's counterclaim.

The judgment did not dismiss the complaint. It adjudicated that the '600 patent "is valid but not infringed," and entered [7] judgment in favor of MTD "except" on the issue of validity and in favor of Radio on the counterclaim. The judgment in favor of Radio on validity was distinct from the judgment against it on infringement.

It would seem that the only way MTD could challenge the judgment of validity was by noting an appeal from that portion of the judgment. If MTD were to prevail in its argument that the claims of the patent were invalid, the result would be not an affirmance of the district court judgment, but a modification that would reverse the adjudication of validity. MTD's argument on validity, therefore, is not an attempt to uphold the judgment of the district court on an alternative ground.

In response to questions about this point at oral argument, counsel for MTD seemingly suggested that it is the

usual practice in patent appeals for a party in its position to argue invalidity without appealing from the portion of the judgment against it on that issue. We are not familiar with the practice on that point in other circuits. MTD, however, may have been misled by that practice in not here appealing on the validity issue. Moreover, Radio apparently agreed with MTD, since neither in its reply brief nor in oral argument did Radio question the appropriateness of MTD's arguing the validity issue.

Although we have grave doubt whether the issue is open to MTD, in view of all the circumstances we shall consider it.

[8] Henceforth, however, a party will not be permitted to argue before us an issue on which it has lost and on which it has not appealed, where the result of acceptance of its argument would be a reversal or modification of the judgment rather than an affirmance. *See, e.g., Helvering v. Pfeiffer,* 302 U.S. 247, 250-51 (1937); 9 J. Moore, B. Ward & J. Lucas, *Moore's Federal Practice* ¶ 204.11[3] (2d ed. 1983).

B. As noted, claims 1 and 2 are the only independent claims in the patent. In claim 1, the wheel is described as being between the legs of the wheelbarrow rather than between the handles at their front end. Claim 2, the specification and the drawings all refer to the wheel in its proper place. The district court held claim 1 valid, rejecting MTD's arguments that it was invalid for indefiniteness and failure to define an operable and useful device. It further held, however, that since the wheel of MTD's wheelbarrow was at the front, that wheelbarrow did not infringe claim 1 of the '600 patent.

Before this court, Radio argues, as it did in the district court, that the statement in claim 1 that the wheel is between the legs is an inadvertent error which we should

disregard, and that we should read the claim in the light of the remainder of the patent disclosure as claiming a wheel between the front ends of the handles. We find it unnecessary to decide that question, however, in view of Radio's statement at oral argument that, if it prevailed on claim 2, it could obtain all the relief it seeks. The parties stipulated in the district court that a [9] determination of validity and infringement of claims 2, 3, and 10 would be controlling with respect to all the claims at issue. Accordingly, we proceed to determine the validity and infringement of independent claim 2.

In this case, our decision that claim 2 is valid necessarily extends to claims 3 and 10. In light of Radio's statement and the lack of any attempt by MTD separately to distinguish claims 3 and 10 from its own wheelbarrows, our determination that claim 2 was infringed makes it unnecessary to decide whether those dependent claims also were infringed.

C. MTD contends that the '600 patent is invalid under *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U.S. 545 (1938). In that case the Supreme Court held that, where the invention was only an improvement in a single element of a combination of old elements, a patent claiming the entire combination was "void as claiming more than the applicant invented." 303 U.S. at 549. The Court reasoned that "the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination." *Id.* at 549-50 (footnote omitted). MTD argues that under *Lincoln Engineering*, the '600 patent is invalid since the only novel element of the invention is the channel-shaped portion at the ends of the cross brace, but the claims cover an entire wheelbarrow, all the other elements of which are old and well-known.

[10] We disagree with MTD that *Lincoln Engineering* requires the invalidation of the claims of the '600 patent.

Contrary to MTD's argument, the channel-shaped portion of the cross brace is not the essence of the invention or its only novel element. To the contrary, as the district court stated in its discussion of obviousness, "[i]t is the totality of all the elements and their interaction with each other which is the inventor's contribution to the art of wheelbarrow making." The "new type of wheelbarrow" that, according to the district court, the '600 patent describes, was the result of a number of novel elements, including (in addition to the channel-ended cross brace) the two-piece handles, their joinder at the middle of the underside of the bowl, the support and the strengthening of that joinder by the cross brace, and attachment to the bowl. In sum, as the district court held, the '600 patent "descri[bed] . . . a new and improved complete wheelbarrow."

Lincoln Engineering does not control this case for another reason. *Lincoln Engineering* was decided more than 20 years before the present patent code was enacted in 1952. The question, therefore, is what significance, if any, that decision has on interpreting and applying the different statutory provisions of the present law.

In *In re Bernhart and Fetter,* 417 F.2d 1395, 163 USPQ 611 (CCPA 1969), the Court of Customs and Patent Appeals, whose decisions bind us, *South Corp. v. United States,* 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982), after discussing *Lincoln Engineering,* held that under the present statute the only proper [11] basis for an old combination rejection is "that portion of section 112 which requires that the claims specifically point out and distinctly claim the invention." 417 F.2d at 1403, 163 USPQ at 618.

In the present case the district court did not discuss the application of that provision of section 112 to the claims at issue. It ruled, however, that each of the claims (other than claim 1 here at issue), "no specific deficiencies in which have been asserted . . . is in compliance with § 112." We conclude that claim 2 meets the statutory requirement that it "particularly point[ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention." Claim 2 covers "[a] wheelbarrow comprising" a number of elements, which it discussed in detail and which fully point out and describe the elements of the invention. MTD, which did not even cite *In re Bernhart and Fetter,* despite the obvious significance of that decision on this point, has not rebutted the presumption of validity of the '600 patent, *Stratoflex, Inc. v. Aeroquip Corp.,* 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *TP Laboratories, Inc. v. Professional Positioners,* 724 F.2d 965, 220 USPQ 577 (Fed. Cir. 1984), which covers this requirement of section 112.

D. The district court held that MTD had not overcome the presumption of validity with respect to its contentions that the claims of the '600 patent were anticipated in the prior art or would have been obvious to one of ordinary skill. MTD repeats both of these contentions here. We conclude that the district court correctly rejected these arguments.

[12] 1. For a patent claim to have been anticipated under 35 U.S.C. § 102, all the elements in the claim (or possibly their equivalents, *see RCA Corp. v. Applied Digital Data Systems, Inc.,* Nos. 83-782 and 83-827, slip op. at 7 (Fed. Cir. Mar. 20, 1984)) must have been disclosed in a single prior art reference or device. *Kalman v. Kimberly-Clark Corp.,* 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); *SSIH Equipment, S.A. v. U. S. International*

Trade Commission, 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983). In holding that the '600 patent was not anticipated, the district court found:

> An examination of the prior art, including the additional ten patents relied upon by the defendant, clearly indicates that in no single pre-existing structure or description are there all of the elements of the plaintiff's patented device or their equivalents. More precisely, no one pre-existing structure or description contains both two-piece handles and a cross brace connecting those handle pieces and also including members extending downwardly and connecting with the bottom of the legs. The '600 patent was therefore not anticipated by the prior art.

We have no basis for rejecting as clearly erroneous these factual findings.

2. In holding that the claimed invention of the '600 patent would not have been obvious to one of ordinary skill in the wheelbarrow art, the district court applied the standards for determining obviousness in *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966). It found that the 10 prior patents MTD relied upon, which had not been before the examiner, "teach nothing relevant which is not taught by the three patents **[13]** cited by the examiner." With respect to the differences between the claimed subject matter and the three prior art references, the district court found that the

> end portions of the cross brace member [of the invention] serve to align and connect the front and rear portions of each two-piece handle. . . . [I]t should be noted the cross brace member of the '600 patent is described in claim 2 as extending 'beneath the bowl,' thus also locating the juncture of the handle pieces

there, unlike the junctures of the two-piece handles in the prior art which are all located behind the bowl.

On the basis of these and other findings, the district court concluded that these differences "are such that the subject matter [of the '600 patent claims] as a whole was not obvious at the time the invention was made to a person having ordinary skill in the art."

The findings upon which the district court based its conclusion of nonobviousness are not clearly erroneous. Claim 2 recites, in pertinent part, "a bowl, a pair of . . . handles . . . with each handle being formed of two pieces . . . [and] a cross brace member extending . . . beneath the bowl with channel sections on the outer end portions . . . with the abutting ends [of the handle portions] in an intermediate portion of the channel section . . . ." Under this claim the juncture of the handle portions necessarily must be located under the bowl. In contrast, in all the wheelbarrows disclosed in the prior art upon which MTD relies, there are either single-piece handles or two-piece handles with a juncture behind the bowl rather than under it as in the '600 patent claims.

[14] There is no indication or suggestion in any of these references that would have made it obvious to shift the location of the handle junctions to beneath the bowl. To the contrary, the uniform indication in the references that the juncture is behind the bowl teaches away rather than toward the claimed invention.

Finally, although the district court found it unnecessary to consider "secondary criteria supporting validity," the record shows significant secondary criteria indicating non-obviousness. The wheelbarrow the '600 patent claims had rapid and great commercial success. The MTD wheelbarrow was virtually a copy of the Radio wheelbarrow ex-

cept for the changed configuration at the ends of the cross brace from channel to flat. In determining obviousness *vel non* the district court must consider all evidence that bears upon the issue, including secondary considerations. *Stratoflex,* 713 F.2d at 1538, 218 USPQ at 879.

III

As noted, the district court determined that the flat-ended cross brace of the MTD wheelbarrow was the equivalent of the channel-ended cross brace claimed in the '600 patent. It held, however, that the MTD wheelbarrow was a "different structure" from the wheelbarrow claimed in the '600 patent because of the filler strips in the MTD wheelbarrow and the lack of any explicit reference to those strips in the claims of the '600 patent. Radio contests the ruling that the lack of any specific reference to the filler strips in the claims of the '600 patent **[15]** prevented infringement. MTD argues that the district court erred in holding that its cross brace was the equivalent of the cross brace disclosed in the '600 patent.

A. Even though a device does not literally infringe the claim of a patent, "a patentee may invoke [the] doctrine [or equivalents] to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'" *Graver Tank & Manufacturing Co. v. Linde Air Products Co.,* 339 U.S. 605, 608, 85 USPQ 328, 330 (1950), *quoting from Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30, 3 USPQ 40 (1929). *See also Caterpillar Tractor Co. v. Berco, S.P.A., etc.,* 714 F.2d 1110, 219 USPQ 185 (Fed. Cir. 1983); *Hughes Aircraft v. United States,* 717 F.2d 1351, 219 USPQ 473 (Fed. Cir. 1983). A finding of equivalency is factual, and will not be overturned on appeal unless clearly erroneous. *Thomas & Betts Corp. v. Litton Systems, Inc.,* 720 F.2d 1572, 220 USPQ 1 (Fed. Cir. 1983).

The district court found that that the flat-ended cross brace was the equivalent of the channel-ended cross brace because

> [t]he claimed function of the end sections of the cross brace in the . . . patent is to secure the handle portions with the two pieces aligned in abutting relationship to form complete handles. The flat ends of the defendant's cross brace perform this same function in substantially the same way—that is, by bridging the handle pieces and being bolted to each piece. . . . Moreover, the cross brace members combine with the other elements in the same manner and in this respect may be considered interchangeable.

[16] These findings are not clearly erroneous. Radio's expert witness, Mr. Hobbs, in comparing the channel-shaped and flat cross braces, testified that the flat cross brace has "the bottom part [of the channel] and not the two ridges on each side. The structure is there and it functions and gives the same result." He stated that it is "the equivalent structure of what is called for in the claims . . . ." A senior design engineer for Radio, Mr. Micheleau, gave similar testimony:

> The court: [Y]ou find the cross bar [sic] member relationships identical between the two wheelbarrows . . . ?
>
> The witness: The total use of the wheelbarrow is the same. The total use of the inner related [sic] parts [is] the same.
>
> * * * * *
>
> Q. [W]ould your conclusion be any different if this cross bar were a completely flat member as opposed to one having this channel embossment in the center?
>
> A. Assuming it is made of sufficient material, it will do exactly the same function.

Indeed, this is precisely the kind of case the doctrine of equivalents is designed to cover. The purpose of the doctrine is to make it impossible for "the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law." *Graver Tank & Mfg. Co.*, 339 U.S. at 607, 85 USPQ at 330.

[17] When MTD reentered the wheelbarrow business in 1980, it neither resumed the production of a prior model nor designed a new one. Instead, it virtually copied the Radio wheelbarrow. When Radio pointed out that this model infringed the '600 patent, MTD's response was merely to change the form of the cross brace to make its ends flat instead of channel-shaped, and, with this minor change, to continue to copy the Radio wheelbarrow.

B. The district court held that "the claims of the '600 patent, which do not contain filler strips, are [not] infringed by the defendant's wheelbarrows, all of which do . . . ." Its rationale was that the filler strips

> are integral structural components included for the very purposes stated in the '600 patent's specification. . . . [T]he inclusion into the defendant's wheelbarrows of filler strips, although not new elements, creates a different structure. . . . [D]efendant's wheelbarrows . . . simply do not infringe upon the plaintiff's patent.

We disagree with the district court on this issue and hold that the MTD wheelbarrow infringed the claims of the '600 patent.

As noted, claim 2 includes "means for securing the handle portions in the channel section." Paragraph 6 of 35 U.S.C. § 112 authorizes expressing an element in a combination claim as a "means" for performing a specified function and states that such a claim "shall be construed

to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." "[W]here a claim sets forth a means **[18]** for performing a specific function, without reciting any specific structure for performing that function, the structure disclosed in the specification must be considered, and the patent claim construed to cover both the disclosed structure and equivalents thereof." *Lockheed Aircraft Corp. v. United States,* 553 F.2d 69, 82, 193 USPQ 449, 460 (Ct. Cl. 1977); *Decca Ltd. v. United States,* 420 F.2d 1010, 1014, 164 USPQ 348, 351 (Ct. Cl.), *cert. denied,* 400 U.S. 865 (1970); *Stearns v. Tinger & Rasor,* 252 F.2d 589, 597-98, 116 USPQ 222, 228 (9th Cir. 1957). In interpreting this "means" clause, we look to the specification to determine whether the corresponding structure includes filler strips.

The specification refers to "the preferred practice of this invention wherein use is made of a filler strip 20 in the form of a wedge-shaped channel member secured as by welding, at 22, to the underside of the bowl . . . ." It states that "the handle portions are secured in their assembled relation . . . to the one piece filler strip on one side and to the one piece leg member on the opposite side securely to interconnect the handle portions in their assembled relationship one to the other . . . ," and refers to the interconnection of "the filler strip, leg members and additionally spaced portions of the handle sections." These and the numerous other references in the specification to the use of the filler strips show that the district court correctly found that one of the functions of the strip was "[t]he rigid and secure assembly of the bowl, handle pieces and leg members."

[19] The filler strips described in the specification thus constituted a "means for securing the handle portions in the channel sections." The "means" language in claim 2 therefore covers the filler strips. The MTD wheel-

barrow which included these strips infringed claim 2 of the '600 patent.

The fact that, because of their triangular shape and placement, the filler strips also performed the additional function the district court noted—"[t]he substantial leveling of the bowl for fuller utilization of its capacity"—cannot avoid a finding of infringement. As the district court recognized, "an accused device cannot escape infringement by merely adding features, if it otherwise has adopted the basic features of the patent." *A.B. Dick Co. v. Burroughs Corp.*, 713 F.2d 700, 218 USPQ 965 (Fed. Cir. 1983), *cert. denied*, 52 U.S.L.W. 3509 (U.S. Jan. 9, 1984) (No. 83-698). Similarly, an accused device that contains the same feature as the patented device cannot escape infringement because in it that feature performs an additional function it does not perform in the patented device. *See, e.g., Maxon v. Maxon Construction Co.*, 395 F.2d 330, 158 USPQ 77 (6th Cir. 1968); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 145 USPQ 6 (10th Cir. 1965).

IV

MTD argues at some length that this is an "exceptional case" for which it is entitled to attorney's fees under 35 U.S.C. § 285. Since MTD did not appeal from the district court's contrary determination, the argument is not open to it **[20]** here. In any event, section 285 permits the court to award attorney's fees only to "the prevailing party"—a status MTD does not have under our decision.

The judgment of the district court is affirmed with respect to validity, is reversed with respect to noninfringement, and the case is remanded to that court for an accounting.

AFFIRMED IN PART, REVERSED IN PART, AND REMANDED.

MEMORANDUM OPINION OF THE UNITED STATES DISTRICT COURT

(Filed June 15, 1983)

Case No. C81-1506

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

RADIO STEEL & MFG. CO.,
Plaintiff,

vs.

MTD PRODUCTS INC,
Defendant.

MEMORANDUM OPINION

DOWD, *J.*

The above captioned cause of action came on for trial before this Court on December 6 and 7, 1982. The following shall constitute this Court's findings of fact and conclusions of law pursuant to Rule 52(a) of the Federal Rules of Civil Procedure.

THE PARTIES

The plaintiff Radio Steel and Manufacturing Company (Radio) brings this action asserting infringement of its United States Letters Patent Number 3,282,600 ('600) against defendant MTD Products Inc (MTD). The defendant has answered Radio's complaint, alleging invalidity and non-infringement, and has counterclaimed for declaratory judgment on these same grounds. Jurisdiction is

founded under 28 U.S.C. §1338(a) and venue under 28 U.S.C. §1400(b).

The plaintiff is an Illinois corporation having its principal place of business in Chicago, Illinois. Roger [2] Tonelli filed the application for the '600 patent on April 29, 1964, and assigned his rights to Radio on September 28, 1965. The patent was issued to Radio on November 1, 1966, and is still owned by the plaintiff.

The defendant is an Ohio corporation having its principal place of business in Cleveland, Ohio.

THE '600 PATENT

The '600 patent is for a wheelbarrow (see diagrams containing figures 1-5, attached as Appendix A). The patent contains ten claims, claims 1 and 2 being independent, and claims 3-10 being dependent upon claim 2.

The claims at issue as to validity and infringement are 1-4, 6-8 and 10, but for purposes of simplifying the issues the parties have agreed and stipulated that the decision of the Court regarding claims 1-3 and 10 will be controlling as to each of the asserted claims.

The plaintiff asserts, as was asserted in the '600 patent, that the structure disclosed in the patent provides the advantages of improved appearance, greater strength and ruggedness, and savings in the production, packaging, shipment, storage and display of such wheelbarrows.

The specific claims at issue read as follows:

1. A wheelbarrow formed of separable parts including:

(1) a bowl;

(2) a pair of elongate handles each having a length greater than the bowl and in which each of the

handles is separable into parts of substantially equal length;

(3) a bumper plate and means for mounting the bumper plate onto the ends of the assembled handles when in position of use;

(4) a cross brace member having channel shaped sections [3] on the opposite ends spaced one from the other by an amount corresponding to the spaced relationship between the handles in their assembled relationship and having a width corresponding to the width of the handles in an intermediate portion thereof to receive the handle portions in fitting relationship within the channel sections and having a length dimensioned to extend beyond the ends of the handle pieces when aligned in abutting relationship one with the other to form the handle and means for securing the handle pieces in the channel sections of the cross brace member;

(5) a pair of leg members comprising elongate strips of a structurally strong material bent to V-shape with the apex of the V lowermost in the assembled relationship to provide a foot rest for the wheelbarrow and with the legs of the V-shaped members extending angularly upwardly and outwardly to engage portions of the handle pieces spaced longitudinally from the abutting edges and means for connecting the ends of the legs to the longitudinally spaced apart portions of the handle pieces and with the leg members spaced laterally one from the other by an amount corresponding to the spaced relationship between the assembled handles;

(6) means for connecting the handles in their laterally spaced apart relationship to the underside of the bowl;

(7) said cross brace member having a portion extending downwardly and outwardly from an intermediate portion thereof to the apex portions of each of the leg members and means for interconnecting said downwardly extending portions with the apex portions of the leg members to prevent spread of the legs and to provide vertical bracing; and

(8) a wheel, and means rotatably mounting the wheel onto the leg members between the forward end portions thereof.

2. A wheelbarrow comprising a bowl, a pair of elongated handles secured to the underside of the bowl in laterally spaced apart relation with each handle being formed of two pieces including a front piece and a rear piece with said pieces being aligned one with the other in end to end abutting relationship to form the handle, a bumper plate and means mounting the bumper plate on the forward ends of the front pieces to interconnect the front pieces in their assembled relation, a cross brace member extending crosswise between the handles and beneath the bowl with channel sections on the outer end portions of the cross brace member spaced one from the other by an amount corresponding to the spaced relationship between the handles and having a width dimensioned [4] to correspond to the width of the handle portions to receive the handle portions therein in fitting relationship and means for securing the handle portions in the channel sections with the two pieces aligned in end to end relation and with the abutting ends in an intermediate portion of the channel section, said cross brace member also including members extending downwardly and outwardly laterally from the central portion thereof for a distance to space the ends by an amount correspond-

ing to the spaced relationship between the handle portions, a pair of leg members formed to V-shape with the upper ends of the V-shaped members being connected to longitudinally spaced apart portions of the handle pieces and means connecting the downwardly extending portion of the cross brace member with the apex portions of the leg members, a wheel and means rotatably mounting the wheel between the front pieces of the handle members.

3. A wheelbarrow as claimed in claim 2 in which the handles are wooden handles.

4. A wheelbarrow as claimed in claim 2 in which the bumper plate comprises a channel shaped member bent to U-shape with the central bail portion dimensioned to have a length corresponding to the spaced relationship between the ends of the handles.

6. A wheelbarrow as claimed in claim 2 in which the cross brace member comprises an intermediate portion of channel shape with the channel sections outwardly thereof.

7. A wheelbarrow as claimed in claim 2 in which the member extending downwardly and outwardly laterally from the central portion of the cross brace member comprises arms extending integrally laterally and downwardly from the central portion of the cross brace member for a distance corresponding to the spaced apex portions off the leg members.

8. A wheelbarrow as claimed in claim 7 in which the arms have flattened end portions lying in abutting relationship with the apex portions of the leg members and in which the means interconnecting the leg members to the cross brace members comprises means interconnecting the flattened end portions with the adjacent apex portions of the leg members.

10. A wheelbarrow as claimed in claim 2 in which the connection between the longitudinally spaced apart portions of the handle pieces and the upper end portions of the leg members include the bowl to [5] rigidly secure the handle pieces, leg members and bowl together in their assembled relationship.

Additionally, the Court notes, although the issue was never raised by either of the parties, that included in the specification, but in none of the claims, are filler strips (20), one of which is positioned between each of the handles and the bowl. According to the specification, the preferred practice involves the use of a filler strip in the form of a wedge shaped channel member secured as by welding to the underside of the bowl and secured by bolts to the handles. In the alternative, the specification suggests that a wooden filler strip (105) may be used, in which case bolts would extend through the filler strip and the bowl to connect the two. The evidence indicates that all of the wheelbarrows of the plaintiff which are said to be made in accordance with the '600 patent and all of the accused wheelbarrows of the defendant include such a wooden piece.

PLAINTIFF'S AND DEFENDANT'S ARGUMENTS

The plaintiff asserts that its '600 patent is valid and that the defendant's wheelbarrow models 411-411, 411-451, and 411-551 infringe the patent. The parties have stipulated and agreed that these models of wheelbarrows are manufactured and sold by MTD within this district.

Radio also argues that the alleged infringement by MTD has been willful and wanton, and therefore that this is an exceptional case within the meaning of 35 U.S.C. §285.

The defendant asserts that the '600 patent is invalid pursuant to 35 U.S.C. §102 for the reason that the subject [6] matter thereof is anticipated by the prior art, pursuant to 35 U.S.C. §103 for the reason that the differences between the subject matter of the claims and the prior art would have been obvious at the time the invention was made to one having ordinary skill in the art, pursuant to 35 U.S.C. §112 for the reason that the claims failed to particularly point out and distinctly claim the subject matter of the invention, and pursuant to the principle of law enunciated in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545 (1937), and other cases following the same. MTD also asserts that the '600 patent, even if valid, is not infringed by any wheelbarrow made by MTD.

Additionally, the defendant contends that Radio has improperly filed and maintained its action against MTD in bad faith, and therefore that this is an exceptional case within the meaning of 35 U.S.C. §285.

Upon consideration, for the reasons stated below, it is the determination of this Court that the '600 patent is valid but not infringed by the defendant.

VALIDITY

Before beginning its analysis, the Court takes note of the point made by the plaintiff that decisions of district courts in patent cases are now reviewed by the United States Court of Appeals for the Federal Circuit, which was established October 1, 1982. It seems clear to this Court that decisions of the Federal Circuit Court as to patent [7] matters will become binding upon the district courts in such cases.

As the plaintiff further indicates, the Federal Circuit Court, in its opinion in the first appeal it heard, held

that the holdings of its "predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, . . . shall be binding as precedent in this Court." *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982). This development, of course, does not render inapplicable the previous decisions of other circuit courts of appeals in patent actions. After all, the true predecessors of the new court in regard to appeals from decisions of district courts in patent cases are the other circuit courts.

Accordingly, this Court will continue to follow the decisions of the Sixth Circuit, and to refer to the decisions of other circuits for guidance where no Sixth Circuit precedent exists, unless a contrary ruling has been made on a particular point of patent law by the new Federal Circuit Court or one of those courts whose holdings it has adopted as precedent.

Additionally, prior to analyzing the patent for validity, an understanding of the nature of the claimed invention disclosed by the patent is necessary. The defendant contends that the plaintiff's invention, if any, is limited to the channel shaped sections on the opposite ends of the cross brace member to receive the handle [8] portions in fitting relationship within the channel sections. To the contrary, the plaintiff asserts that the channel shaped ends of the cross brace are not even a significant feature of the claimed invention, but that instead it is the totality of several elements and their interrelationship which cooperate to form a patentable invention. The plaintiff thus having abandoned any interest it might arguably have had solely with respect to the channel shaped ends of the cross brace, the '600 patent will be analyzed on the basis of its asserted description of a new and improved complete wheelbarrow.

The patentability of any claimed invention is dependent upon the three essential characteristics of novelty, utility, and non-obviousness, which are codified in 35 U.S.C. §§101-103, and which constitute separate tests, each of which must be met in order for a patent to be valid. *United States v. Adams,* 383 U.S. 39, 48 (1966); *American Seating Co. v. National Seating Co.,* 586 F.2d 611, 615 (6th Cir. 1978), *cert. denied,* 441 U.S. 907 (1979). These essential characteristics derive from the standard of patentability expressed in Article I, §8, Clause 8 of the Constitution, which states that patents are to be granted to "promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries."

[9] Moreover, a patent may be faulty and thus invalid if it fails to meet the requirement of 35 U.S.C. §112 that it particularly point out and distinctly claim the invention.

Presumption of Validity

The starting point in analyzing a challenge to a patent's validity is the statutory presumption that the patent is valid under 35 U.S.C. §282, which states in part:

> A patent shall be presumed valid. The burden of establishing the invalidity of a patent shall rest on a party asserting it.

The presumption of validity is based upon the acknowledged experience and expertise of the Patent Office and upon the fact that the issuance of a patent constitutes a type of administrative determination supported by evidence. *American Seating,* 586 F.2d at 615. The presumption has no independent evidentiary significance, however, as it merely serves to allocate to the party claiming in-

validity the burden of proving it. In a typical case, where the bulk of the evidence of the prior art is contained in documents, the standard of proof is that of a preponderance of the evidence. *Eltra Corp. v. Basic, Inc.*, 599 F.2d 745, 750 (6th Cir. 1979), *cert. denied*, 444 U.S. 942 (1979).

It is firmly established that the presumption of validity is weakened greatly where the Patent Office has failed to consider pertinent prior art. *Universal Electric Co. v. A.O. Smith Corp.*, 643 F.2d 1240, 1245 (6th Cir. 1981). The degree by which the presumption is weakened in cases in which relevant prior art was not considered by the **[10]** Patent Office depends upon a balancing of the pertinence of the newly cited prior art and the pertinence of the prior art actually considered by the patent examiner in the prosecution of the patent application. *American Seating, 586 F.2d at 615.* Conversely, where the most pertinent prior art has been considered, the presumption is greatly strengthened. *Hanson v. Alpine Valley Ski Area, Inc.*, 611 F.2d 156, 159 (6th Cir. 1979).

The prior art presented to the Court for consideration in this case consists entirely of earlier patents. Three patents were cited by the examiner and made of record:

No. 187,549	Nutting	1877
No. 1,622,354	Smith	1927
No. 1,630,975	Smith	1927

The examiner noted in his examination of the original application, which when amended resulted in the granting of the '600 patent, that he cited the Nutting patent because it shows a wheelbarrow provided with a transverse brace having depending arms, the Smith '354 patent because it shows a bumper for a wheelbarrow, and the Smith '975 patent because it shows a two-piece wheelbarrow handle

and two channeled members or brackets which, along with bolts, are used to connect the handle pieces together.

All of the patents cited by the examiner, of course, describe wheelbarrows having the general combination of a wheel, bowl, handles, and supporting legs.

[11] Other features of the cited patents are relevant to the validity of the '600 patent. The Smith '354 patent describes in claim 5 the connection of certain elements by "securing bolts passing through said hopper [known in the '600 patent as the bowl], channel bars [filler strips], arms [handles] and legs. . . ." The Smith '975 patent shows a sectional wheelbarrow capable of being "knocked down" and arranged in a carton or a similar container not much larger than a bowl for convenient packing and shipment.

In support of its position that the '600 patent is invalid, the defendant has referred to and relied upon ten other patents which were granted before the plaintiff's:

No. 155,084	Harrison	1874
No. 258,323	Shumaker	1882
No. 355,245	Annin	1886
No. 562,139	McCabe	1896
No. 686,298	Hoffmann	1901
No. 888,055	Baker	1908
No. 1,242,418	Booth	1917
No. 1,559,646	Roemer	1925
No. 1,578,213	Smith	1926
No. 3,170,707	Millar	1965

Upon examination of these patents, the Court concludes that none of them demonstrates any features disclosed by the '600 patent which are not represented in the cited

art. The Baker patent, in fact, does not describe a complete wheelbarrow, but rather a wheelbarrow clip for fastening a [12] leg to a handle in a way not practiced in the '600 patent or relevant to this analysis. Thus, while nine of the additional patents referred to by the defendant are pertinent, they teach nothing relevant which is not taught by the three patents cited by the examiner.

No pertinent prior art having been shown whose teachings were not considered by the examiner, the presumption of validity obtains.

Definiteness and Particularity

The Court believes that it would be wise to first consider the alleged invalidity of the '600 patent, and especially claim 1, for failure to particularly point out and distinctly claim the invention.

Title 35 U.S.C. §112 states:

> The specification shall contain a written description of the invention, and of the manner and the process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The standard of definiteness is one of reasonableness under the circumstances, and the teachings of the prior art and the nature of the particular invention are to be

considered in determining whether the claims meet the statutory requirement of definiteness and particularity. *Antonious v. ProGroup, Inc.*, 699 F.2d 337 (6th Cir. 1983).

[13] The defendant contends that claim 1 is invalid for indefiniteness and failure to define an operable and useful device because clause (8) specifies: "a wheel, and means rotatably mounting the wheel unto the *leg members* between the forward end portions thereof" (emphasis added). In the specification, drawings, and other claims of the '600 patent, the wheel is mounted between the forward ends of the handles and not between the legs.

The plaintiff argues that the statement in clause (8) of claim 1 that the wheel is attached to the legs is obviously an inadvertent error which does not detract from the intended meaning of the claim. It is fundamental that claims are to be construed in light of the specification and both are to be read with a view to ascertaining the invention. *Adams*, 383 U.S. at 49. However, the invention is measured by the claims and not by the specification. *Philips Industries, Inc., v. State Stove & Manufacturing Co., Inc.*, 522 F.2d 1137, 1140 (6th Cir. 1975). The inconsistency between claim 1 and the specification, drawings, and other claims thus cannot be explained away as the plaintiff suggests. The claim itself is quite clear, and therefore, despite the plaintiff's invitation, this Court will not read "leg" to be "handle."

The defendant also contends that claim 1 describes an inoperable wheelbarrow and that the claim should be declared invalid for that reason. Although the claim describes a type of wheelbarrow not likely ever to be constructed, no **[14]** evidence has been presented to support the position that such a wheelbarrow would be inoperable, and thus the Court will not so declare.

Having closely examined the other claims, no specific deficiencies in which have been asserted, the Court concludes that each of them also is in compliance with §112.

Anticipation

Title 35 U.S.C. §102 states in pertinent part:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent . . . .

This reason why an invention is not novel and, therefore, why a patent should not be granted is generally referred to as anticipation. The Sixth Circuit has repeatedly defined the proper standard with respect to anticipation as requiring that all the elements of a patented device or their equivalents be found in a single pre-existing structure or description. *American Seating,* 586 F.2d at 618. The Supreme Court has stated a doctrine of equivalents as follows:

> [A] patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.' *Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30, 42. The theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.' *Machine Co. v. Murphy,* 97 U.S. 120, 125. . . .
>
> What constitutes equivalency must be determined **[15]** against the context of the patent, the prior art,

> and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. . . . Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function with which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangability of an ingredient not contained in the patent with one that was.

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608-609 (1950).

An examination of the prior art, including the additional ten patents relied upon by the defendant, clearly indicates that in no single pre-existing structure or description are there all of the elements of the plaintiff's patented device or their equivalents. More precisely, no one pre-existing structure or description contains both two-piece handles and a cross brace connecting those handle pieces and also including members extending downwardly and outwardly from its central portion and connecting with the bottom of the legs. The '600 patent therefore was not anticipated by the prior art.

Non-obviousness

Title 35 U.S.C. §103 states:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

> whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[16] Essentially, non-obviousness is the statutory equivalent of the requirement of "invention," derived from the Supreme Court's decision in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851). *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 279 (1976); *Eltra*, 599 F.2d at 751.

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the first case in which that court discussed §103, set forth the standard of inquiry which has been followed ever since:

> Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham, 383 U.S. at 17-18.

Scope and Content of the Prior Art

The Sixth Circuit has defined the boundaries of "prior art" as follows:

> Prior art need not be exactly the same in order to be applicable; differences between the prior art

> and the invention are permitted. This is to say that the mere existence of differences between the prior art and an invention does not establish the invention's non-obviousness, particularly where, as here, the prior art and the invention are substantially similar. . . .
>
> [T]he object and the accompanying claims as well as the inferences one skilled in the art would draw from such specific disclosures, properly constitute prior art. In fact, "The prior art is all the knowledge that would have been available to any **[17]** person having ordinary skill in the art." *Steelcase, Inc. v. Delwood Furniture Co.*, 578 F.2d 74 (5th Cir. 1978), *cert. denied*, 440 U.S. 960. . . (1979).

Smith v. ACME General Corp., 614 F.2d 1086, 1093 (6th Cir. 1980).

The scope and content of the prior art presented to the Court for consideration have already been fully been described in the section of this opinion discussing the presumption of validity.

Differences Between the Prior Art and the Claims at Issue

As noted previously, claim 1 of the '600 patent describes a wheelbarrow with a wheel attached to the legs. Clearly, no such arrangement of elements exists in the prior art. This difference between the claim and prior art is so extreme that no further comparison need be made.

Likewise, a comparison of the prior art and claims 2, 3, and 10, the latter two being dependent upon claim 2, need proceed no further than an examination of the cross brace member in the '600 patent and cross braces in previous wheelbarrows. Like all cross braces used in

wheelbarrows, the one in the '600 patent spans the distance between and is secured to the handles. Furthermore, the '600 cross brace member also includes "members extending downwardly and outwardly laterally from the central portion thereof" and connecting with the legs at their bottom points which function in the same way and for the same purpose as the brace in the Nutting patent which "is secured centrally to [18] the under side of the cross-piece . . . and projects downwardly to the sides to form the supports or legs." None of the prior art, however, discloses "a cross brace member . . . with channel sections on the outer end portions . . . having a width dimensioned to correspond to the width of the handle portions to receive the handle portions therein in fitting relationship and means for securing the handle portions in the channel sections with the two pieces aligned in end to end relation and with the abutting ends in an intermediate portion of the channel section" as does the '600 patent.

The defendant contends that the Roemer patent incorporates a cross brace member and channels on its opposite ends which are not integral with the cross brace member but which, along with the cross brace member, form a structure coming within the language of claim 2 specifying "channel sections *on* the opposite end portions of the cross brace member" (emphasis added). The defendant fails to note, however, that the channels it points to in the Roemer patent are the angularly-bent extremeties of the legs, not separate channel pieces. Moreover, a reading of the '600 patent in light of the specification and drawings indicates that the channel sections are indeed integral parts of a cross brace member described as having its "end portions being formed with a downturned portion 78, a flat horizontally disposed portion 80,

and an upwardly turned end flange 82 to define a length wise channel section. . . ." **[19]** Thus, the prior art does not contain a cross brace member such as that in the '600 patent.

More important than the shape of the channel sections which have drawn so much attention in this action, though, is the fact that these end portions of the cross brace member serve to align and connect the front and rear portions of each two-piece handle. No prior art discloses a cross brace member which incorporates this additional function. Finally, it should be noted that the cross brace member of the '600 patent is described in claim 2 as extending "beneath the bowl," thus also locating the juncture of the handle pieces there, unlike the junctures of the two-piece handles in the prior art which are all located behind the bowl. This location provides a different and improved interrelationship among the elements.

Level of Ordinary Skill in the Art

This Court finds as a matter of fact that the level of ordinary skill in the art of wheelbarrow design and manufacture is that level of skill possessed by the members of the plaintiff's and defendant's engineering departments responsible for the development and production of wheelbarrows. These are the people who devote regular and substantial effort to solving the type of problem that the '600 patent addresses, and who have the educational background, experience and information available to them which is necessary to solve such a problem as constructing a rugged sectional wheelbarrow with two-piece handles.

[20] *Obviousness/Non-obviousness*

The defendant asserts that the '600 patent discloses a combination of elements all of which are old and disclosed in the prior art or, at the very most, discloses a combination which includes only one new element, that being an improved cross-brace member. Based upon this assertion, the defendant further contends that the '600 patent must meet the high standard for "combination patents" in order to be valid.

The *Stewart-Warner* case states in pertinent part:

> The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.

303 U.S. at 549-50 (footnote omitted). The Supreme Court in that case went on to conclude that the patent involved was void as claiming more than the applicant invented.

In another case involving a combination of old elements, the Supreme Court stated that "[a] combination of elements may result in an effect greater than the sum of the several effects taken separately," and that such "synergistic result" makes the combination patentable. *Anderson's-Black Rock, Inc., v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 61 (1969).

The test for "synergism," however, need not be reached in the instant case, because the '600 patent is not a combination patent. Rather, after carefully examining the **[21]** exhibits and considering the testimony, the Court

finds that the multi-purpose cross brace member is not simply an improvement of an old part but is instead a new element the inclusion of which into the '600 patent yields a design for a new type of wheelbarrow. It is the totality of all the elements and their interaction with each other which is the inventor's contribution to the art of wheelbarrow making.

Accordingly, the Court concludes that the differences between the subject matter of the '600 patent and the prior art are such that the subject matter as a whole was not obvious at the time the invention was made to a person having ordinary skill in the art. In light of this conclusion, consideration of secondary criteria supporting validity is unnecessary.

The Court having found no violation of 35 U.S.C. §§102, 103, or 112, the '600 patent is hereby declared to be valid.

INFRINGEMENT

The Sixth Circuit has stated that two tests must be applied in determining whether a patent has been infringed by an accused device. The first test is whether there is literal infringement of the patent. In making this determination, the words of the claim in the patent must be compared with the accused device, and if the accused device is clearly within the claim, literal infringement is established. The second test is the application of the doctrine of equivalents. *Acme Highway Products Corp. v. The* [22] *D. S. Brown Co.*, 473 F.2d 849, 850 (6th Cir.), *cert. denied*, 414 U.S. 824 (1973).

In the *Machine Co.* case, the Supreme Court said that, in determining the question of infringement, the fact finder is to

look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.

Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as at the means by which the result is attached.

Machine Co., 97 U.S. at 125.

Many pages of briefs and hours of testimony in this action have been devoted to the similarities and differences between the cross brace members of the plaintiff's patent and the defendant's wheelbarrows. There is no question that the defendant's cross brace, with its flat ends, is of a somewhat different shape than the cross brace of the plaintiff's patent, which has channel shaped sections on its opposite ends. Therefore, there is no literal infringement.

The plaintiff contends, however, that the defendant's cross brace is the equivalent of the cross brace in the '600 patent. This Court agrees. The claimed function of the end **[23]** sections of the cross brace in the plaintiff's patent is to secure the handle portions with the two pieces aligned in abutting relationship to form complete handles. The flat ends of the defendant's cross brace perform this

same function in substantially the same way—that is, by bridging the handle pieces and being bolted to each piece. It is true that the specification of the '600 patent states that "[t]he handle members are gripped by the channel sections 80 of the cross brace member in a manner to militate against lateral displacements or relative movements between the sections," but no such function is asserted in any of the claims of the patent. Moreover, the cross brace members combine with the other elements in the same manner and in this respect may be considered interchangeable. Therefore, if determination of infringement of the '600 patent by the defendant's wheelbarrows involved only consideration of the equivalency of the cross brace members, this Court would conclude that the patent was indeed infringed.

However, upon careful examination of the exhibits and consideration of the testimony, the Court finds that there exists a significant difference between the structure claimed in the '600 patent and that of the defendant's wheelbarrows. As noted previously in this opinion, filler strips, one of which is positioned between each of the handles and the bowl, are mentioned frequently in the specification of the '600 patent and are included in both [24] the plaintiff's and the defendant's wheelbarrows, but are not mentioned at all in the claims of the patent. The relevant portions of the specification state:

> In the preferred practice of this invention wherein use is made of a *filler strip* 20 in the form of a wedge shaped channel member secured as by welding, at 22, to the underside of the bowl in laterally spaced apart relation for attachment of the bowl to the under-carriage, the extension of securing bolts through the bottom wall 14 of the bowl 10 for attachment to the under-carriage can be eliminated, whereby the bowl

presents a smooth surface which is uninterrupted by the heads of the bolts . . . .

The channel member 20, shown in greater detail in FIGS. 3 and 4, is formed with a bottom wall 24 and laterally spaced apart perpendicular side walls 26 which are secured at their upper edge, as by welding 22, to the underside of the bowl 10. The bottom walls are provided with longitudinally spaced apart key slots 28 with the key slots having an opening at one end of larger dimension to enable the heads 30 of carriage bolts 32 to pass through the openings but wherein the slots 28 are of smaller dimension than the head but of greater width than the shank of the carriage bolts to enable the latter to be displaced longitudinally therethrough to position the carriage bolts in the slot for attachment of the bowl to the under-carriage, as illustrated in FIGS. 1 and 4. Instead of making use of keyhole slots as illustrated, use can be made of slots extending inwardly from the ends of the channel members for longitudinal displacement of the carriage bolts therethrough to position of use.

• • •

. . . Openings 56 are provided to extend vertically through both the front and rear [handle] pieces in a portion spaced from the abutting ends and in position for vertical alignment with the slotted portions 28 in the *filler strips* for passage of the channel bolts 32 through said openings to effect attachment of the bowl and channel onto the handle portions. . . .

. . . Thus the handle portions are secured in their assembled relation at spaced apart portions to the one piece *filler strip* on one side and to the one piece

leg member on the opposite side securely to [25] interconnect the handle portions in their assembled relationship one to the other and to the bolt.

. . . The channel sections in the opposite ends of the cross brace member 72 are spaced one from the other by an amount to correspond with the spaced relationship between the pair of handle pieces and the *filler strips* so as to receive the lower portions of the handle pieces, at their abutting ends, in fitting relationship within said channel sections of the cross brace members. The elements are secured in their assembled relationship by bolt and nut means 88 wherein the elongate bolts extend downwardly through the aligned openings in the handle pieces and the channel members 80 with a threaded end portion extending through and beyond the channel members threadably to receive a fastening nut. In the preferred practice, the head of the bolt can be welded directly unto the underside of the metal *filler strip* 20 to form a part thereof or else it can be inserted into the channel bracket of the *filler strip* by providing additional longitudinally aligned key slots of the type previously described and arranged to position the bolts in vertical registry with the aligned openings in the abutting ends of the handle pieces and the channel section of the cross brace member.

. . .

As shown in FIG. 3 of the drawing, the entire assembly can be broken down into separate pieces including the leg members 60, the cross brace member 72, the bumper 46, the two piece handle portions 40a and 40b and the bowl 10 with the attached *filler strips* of channel section 20. . . .

In assembly, the carriage bolts 32 are positioned on the channel brackets. The center bolts 88 are inserted through the aligned openings in the handle portions and then the openings in the channel sections on the ends of the cross brace members are brought into position so that the threaded ends of the bolts 88 will extend therethrough and the nut members are thereafter threaded unto the through-extending portions to interconnect the spaced portions of the aligned handle sections with the one piece cross brace member and the one piece longitudinally extending *filler strip.*

The carriage bolts 32 on the outer ends of the *filler strips* are inserted through the outer of the spaced openings of the handle members and through the underlying openings in the flanges 66 at the upper ends of the leg members 64 and the nut members 70 are threaded onto the through-extending threaded end **[26]** portion to interconnect the *filler strip,* leg members and additionally spaced portions of the handle sections. . . .

The *filler strip* in the form of the metal channel bracket 20 of FIGS. 1 and 4 can be replaced with a wooden *filler strip* of the type shown in FIG. 5 wherein the *filler strip* 105 is formed with the same four spaced apart openings 104 and 106 for the passage of the carriage bolts therethrough but wherein the filler strip is countersunk, as at 108, about the center openings 106 to enable the head of the carriage bolt to be received therein. In the use of the wooden *filler strip* of FIG. 5, the bottom wall of the bowl is formed with openings adapted to be aligned with the outer openings 104 in the *filler strips* for the insertion of the carriage bolts therethrough. In such event,

the heads of the bolts will project upwardly from the bottom wall of the bowl unless the latter is countersunk.

The *filler strips* are tapered, as illustrated, to compensate for the angle which the handles make with the horizontal so that, when the *filler strips* are disposed between the handle portions and the underside of the bowl, the latter will be substantially horizontally disposed for fuller utilization of the capacity of the bowl.

. . . In the assembled relation, each handle piece is secured in longitudinally spaced apart relation to the *filler strip* with one portion connected to the horizontally spaced apart portions of the one piece foot member while other portions are secured to the one piece cross brace member. Thus the handles are rigidly secured in the assembly. . . . The supported legs of the cross brace member are inclined toward the foot piece of the leg members in a manner to prevent spread thereby to provide a rigid support while the legs of the foot members are fixed in their longitudinally spaced apart relation to the longitudinally spaced apart portions of the one piece *filler strip* to prevent spread or relative movements therebetween. The members are thus interconnected one to another in the assembly to provide a strong and fixed assembly having strength and stability as great as, if not greater than, that capable of being achieved by pre-assembled units of the type heretofore produced. (emphasis added)

Thus, inclusion of filler strips accomplishes several functions, including:

[27] 1. In the preferred practice employing a metal filler strip, indicated in FIGS. 1-4, the elimination of the need to extend the securing bolts through the bottom of the bowl (in the alternative practice employing wooden filler strips, indicated in FIG. 5, this advantage is not achieved);

2. The rigid and secure assembly of the bowl, handle pieces, and leg members; and

3. The substantial leveling of the bowl for fuller utilization of its capacity.

Pieces such as the filler strips are not new elements in the design and construction of wheelbarrows, but rather were well known in the prior art and were included in the Millar, Roemer, and all three Smith patents. Inclusion of such pieces is not necessary, of course. The Nutting, Harrison, and Annin patents demonstrate that handles may be attached to the underside of a bowl without such pieces.

The Sixth Circuit has consistently held that specific elements, absent in the claims, may not be inferred by reference to the specification. *Antonious*, 699 F.2d at 340; *Philips*, 552 F.2d at 1140.

The wheelbarrow described in claim 1 is stated to be formed of separable parts including "means for connecting the handles in their laterally spaced apart relationship to the underside of the bowl." Limited by *Antonious* and *Philips*, this Court cannot infer that the term of art, i.e., "means," acts to incorporate into the claim the filler strips and all the functions they provide. Claim 2 likewise **[28]** makes no specific reference to filler strips, but states only that "a pair of elongate handles [are] secured to the underside of the bowl . . . ."

The question thus presented is whether the claims of the '600 patent, which do not contain filler strips, are infringed by the defendant's wheelbarrows, all of which do contain them. The Court is well aware that an accused device cannot escape infringement by merely adding features, if it otherwise has adopted the basic features of the patent. *Acme Highway Products,* 473 F.2d at 855. In the defendant's wheelbarrows, however, the filler strips are not simply add-ons, but are integral structural components included for the very purposes stated in the '600 patent's specification. Just as the inclusion into the '600 patent of the multi-purpose cross brace results in a new type of wheelbarrow with a new, improved, and specific interaction among its elements, so the inclusion into the defendant's wheelbarrows of filler strips, although not new elements, creates a different structure. The plaintiff's own witness, Frederick J. Micheleau, stated with reference to the structure shared by the plaintiff's and defendant's products:

> What is unique about this wheelbarrow, that load will push on this handle to form it to flex or bend, in essence trying to break it at some point. . . .
>
> By investigating it, you can see when the load is pushing down on these handles the load is transferred through the pole bowl, through the *filler pieces* onto these handles, causing them to flex. You can see the forces are forced onto this cross brace member, transmitted in a downward motion into the cross brace, **[29]** in turn forcing on the legs, in turn bolted to the legs, forming one essentially strong essential element.
>
> . . .

> Yes, it is a combination of the total structure, taking the bowl held with the bolts, the *filler piece*, the handles, the legs, cross brace and cross bar. (emphasis added)

Transcript at 145-146. It is the conclusion of this Court that the defendant's wheelbarrows, although bearing a striking resemblance to the plaintiff's products, simply do not infringe upon the plaintiff's patent.

EXCEPTIONAL CASE/ATTORNEY FEES

Title 35 U.S.C. §285 states: "The court in exceptional cases may award reasonable attorney fees to the prevailing party." The Sixth Circuit has consistently held that in order to support an award of attorney fees in a patent case there must be a showing of conduct which is unfair, in bad faith, inequitable, or unconscionable. Only the most frivolous of allegations should give rise to an award of attorney fees under §285. *Eltra,* 599 F.2d at 758.

In light of this Court's holding that the plaintiff's patent, though valid, describes a type of wheelbarrow—actually, two different types of wheelbarrows, considering the different wheel placement in each of the independent claims—unlike those made by either the plaintiff or the defendant, and in light of the fact that the key to the defendant's non-infringement was discovered by neither **[30]** party, this Court cannot find that this case is "exceptional" within the meaning of §285.

Each party shall pay its own costs.

/s/ David D. Dowd, Jr.
U. S. District Judge

BEST AVAILABLE COPY

Nov. 1, 1966 R. TONELLI 3,282,600

WHEELBARROW

Filed April 29, 1964 2 Sheets-Sheet 1

FIG. 1

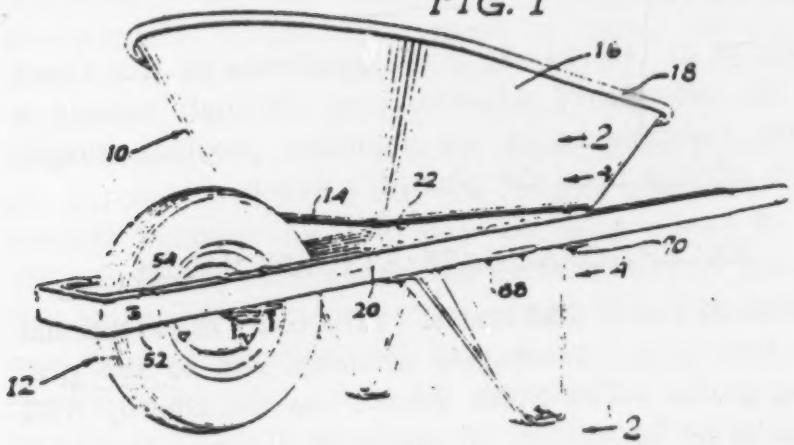
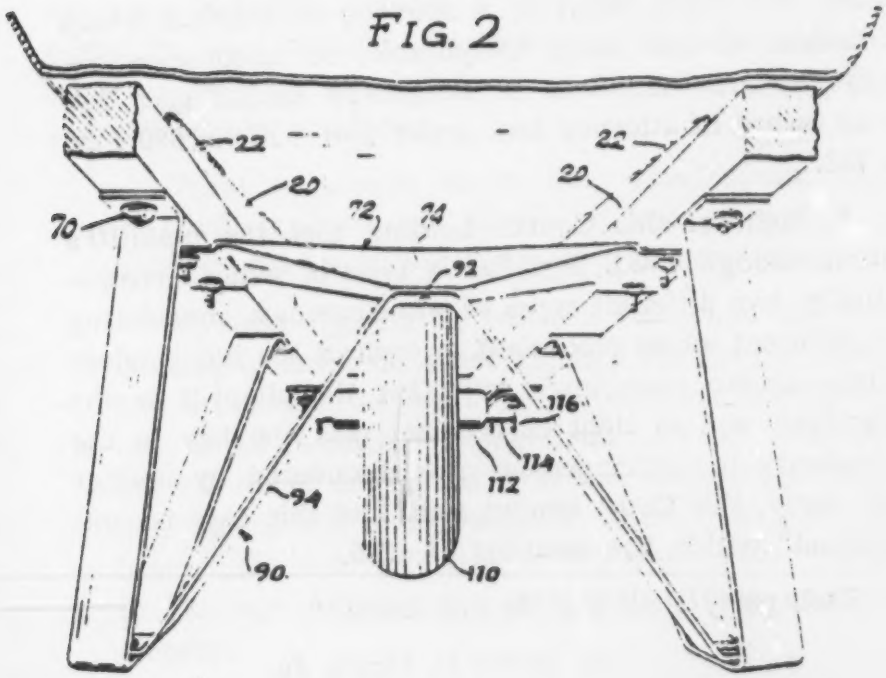


FIG. 2



INVENTOR
Roger Tonelli

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Appendix A

Nov. 1, 1966 R. TONELLI 3,282,600

WHEELBARROW

Filed April 29, 1964 2 Sheets-Sheet 2

FIG. 3

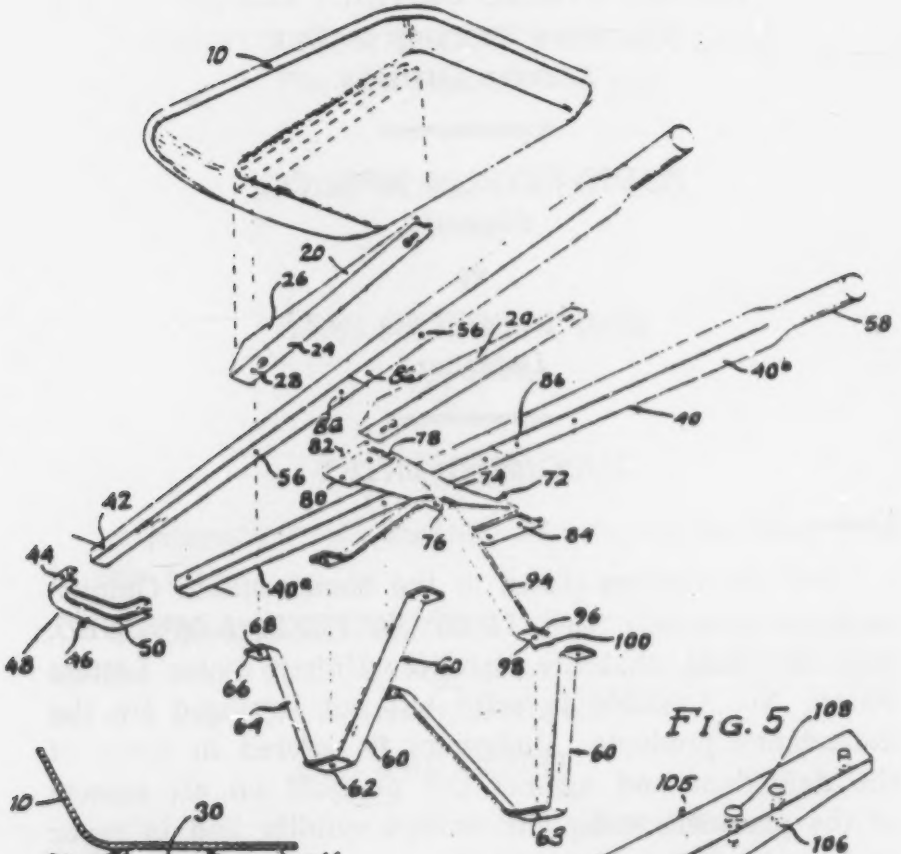
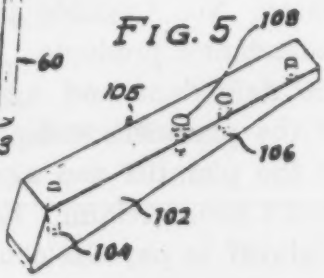


FIG. 5



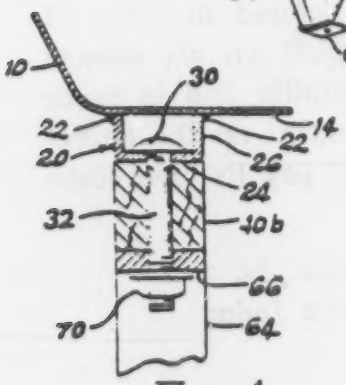


FIG. 4

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JUDGMENT ENTRY OF THE UNITED STATES DISTRICT COURT

(Filed June 15, 1983)

Case No. C81-1506

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

RADIO STEEL & MFG. CO.,
Plaintiff,

vs.

MTD PRODUCTS INC.,
Defendant.

JUDGMENT ENTRY

DOWD, *J.*

For the reasons stated in the Memorandum Opinion contemporaneously filed, IT IS ORDERED, ADJUDGED, and DECREED that the plaintiff's United States Letters Patent No. 3,282,600 is valid but not infringed by the defendant's products. Judgment is entered in favor of the defendant and against the plaintiff on all aspects of the plaintiff's complaint except validity and in favor of the plaintiff and against the defendant on the defendant's counterclaim. Each party shall pay its own costs. Plaintiff to pay the court costs.

/s/ DAVID D. DOWD, JR.
U. S. District Judge

ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING REHEARING

(May 2, 1984)

No. 83-1231

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RADIO STEEL & MFG. CO.,
Appellant,

v.

MTD PRODUCTS, INC.,
Appellee.

ORDER

A suggestion for rehearing in banc having been filed in this case,

UPON CONSIDERATION THEREOF, it is Ordered by the court that the suggestion for rehearing in banc be, and the same is hereby, Declined.

FOR THE COURT

/s/ GEORGE E. HUTCHINSON
Clerk